REMARKS

The Office Action mailed on November 12, 2008 (herein referred to as the "Office Action"), has been carefully considered. Accordingly, the changes presented herewith, taken with following remarks, are believed sufficient to place the present application in condition for allowance. Reconsideration is respectfully requested.

Claims 1-24 and 29-45 are currently pending, with claims 6, 8, 12, 13, 19, 21, 25-28, 34, 36, and 40 being withdrawn from consideration. Claims 10, 11, 23, 24, 38, and 39 stand objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including the limitations of the base claim and any intervening claims.

Claims 1, 3, 4, and 15-17 stand rejected under 35 U.S.C. 103(a) as being unpatentable over USPN 6,106,494 ("Saravia"). Claims 2 and 14 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Saravia in view of USPN 5,476,448 ("Urich"). Claims 5, 7, 9, 18, 20, 22, and 41-44 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Saravia in view of JP 2000-120602 ("Rehn"). Claims 29-32 and 45 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Saravia in view of USPN 5,554,894 ("Sepielli"). Claims 33, 35, and 37 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Saravia in view of Sepielli and further in view of Rehn. Applicants traverse all of these rejections for the reasons set forth below.

Claims 6, 8, 12, 13, 34, 36, and 40 have been withdrawn by the Office from further consideration as being drawn to a non-elected species. Because claims 1 and 29 are believed allowable, Applicants respectfully request that claims 6, 8, 12, 13, 34, 36, and 40 be reinstated as depending from an allowable base claim.

Claims 1, 3, 4, and 15 Are Patentable Over Saravia.

Saravia discloses a fluid management system that is employed to supply a sterile distention solution to a surgical site within a body and, more particularly, the joint capsule of a knee. Saravia, column 4, lines 28-31. Saravia further discloses that the system includes an accumulator 29, the body of which is a balloon 198. Saravia, column 8, lines 61-67. Saravia also discloses that the system includes a valve in the form of a plunger 214 and a mating sleeve 208. The valve prevents backflow by the action of the plunger 214 moving towards the sleeve 208. Saravia, column 13, lines 43-47.

By contrast, claim 1 is directed to an infusion source for a ocular surgery comprising, in pertinent part, a tubular member separate from, and in a parallel fluid relationship with, an irrigation line, the tubular member in fluid communication with the irrigation line and the irrigation lumen, the tubular member having an expandable wall configured to expand during occlusion of an aspiration lumen. Saravia does not disclose or suggest all the limitations of claim 1.

For example, Saravia does not disclose or suggest a tubular member separate from, and in a parallel fluid relationship with, an irrigation line. Rather, Saravia discloses an accumulator 29 comprising a balloon 198 that is in-line with a in flow tube 28. Saravia, column 8, lines 61-67.

The Office Action asserts on page 4 that it would be obvious to one of ordinary skill in the art to modify the system of Saravia such that an additional "accumulator" placed in the draining outflow line 34 is separate from, and in parallel fluid communication with, the irrigation line 28, to prevent backflow or drainage pressure buildup. Applicants respectfully traverse and assert that one of skill in the art would not have a motivation to make such a modification nor an expectation of success. Furthermore, even if Saravia were so modified, such modification still would not disclose all the elements of claim 1.

One of skill in the art would have no motivation to modify Saravia by placing the accumulator 29 comprising balloon 198 in an aspiration line, at least because Saravia does not disclose, or even suggest, that balloon 198 is suitable for use in an aspiration line. Instead, Saravia only discloses use of accumulator 29 in a pressurized irrigation line, wherein the balloon 198 expands to receive fluid and contracts to move fluid out towards a surgical site. Saravia, column 13, lines 47-55.

In support of its position that it would have been obvious to modify Saravia, the Office Action merely makes a conclusory statement to the effect that: "The expandable wall of the accumulator in the outflow aspiration line 34 suggested by Saravia is configured to expand during occlusion of an aspiration lumen 32 due to pressure buildup at a surgical site disclosed by Saravia." Office Action, page 4. The Office Action provides no evidence in support of the assertion Saravia is configured to expand during occlusion of an, either from Saravia or from any other prior art source. Instead, the Office Action supports its assertion base on another conclusory statement that "such an accumulator would be equally capable of preventing backflow of suction." Again, the Office Action provides no evidence to support this assertion. Applicants request the Office provide evidence in support of the assertion the accumulator 29 (in the form of balloon 198) of Saravia is capable of preventing backflow of suction, or at least an example of how balloon 198 of Saravia could be configured in a suction line to prevent backflow.

Applicants respectfully assert that accumulator 29 (balloon 198) does not even prevent backflow in irrigation line 28 of Saravia. To the contrary, Saravia discloses that back flowing fluid fills the balloon 198 and the balloon expands to receive this fluid. Saravia, column 13, lines 47-48. Rather than balloon 198 of accumulator 29 preventing backflow, Saravia discloses that if back up occurs, the back pressure causes plunge 214 to move towards the inward connector sleeve 208. This action prevents the fluid in the accumulator 29 from continuing to back flow. Saravia, column 13, lines 43-47. If Saravia does not even disclose that accumulator 29 (balloon 198) prevents backflow in an irrigation line, it is not reasonable to assert, as in the Office Action, that accumulator 29 (balloon 198) prevents backflow in an aspiration line. **Thus, the Office Action fails to provide any valid reason whatsoever for why one of skill in the art would modify Saravia by placing an accumulator 29 or balloon 198 in an aspiration line in order to meet the claim 1 limitation of a tubular member separate from, and in a parallel fluid relationship with, an irrigation line.**

In addition, one of skill in the art would not have an expectation of success for the proposed modification of putting the accumulator 29 of Saravia in an aspiration line to prevent backflow, since, as discussed in the previous paragraph, Saravia does not even disclose that accumulator 29 or balloon 198 prevent flow when located in irrigation line 28.

In response to Applicants' arguments, page 2 of the Office Action asserts that Saravia discloses an accumulator that "is 'capable of'" use in a suction line. By contrast, claim 1 positively sets forth a tubular member that actually is (not simply capable of being) separate from, and in a parallel fluid relationship with, an irrigation line.

However, even assuming *arguendo* that Saravia does disclose an accumulator that is capable of use in a suction line, such modification of Saravia still does not disclose all the limitations of claim 1. For example, Saravia does not disclose a tubular member separate from an irrigation line having an expandable wall configured to expand during occlusion of an aspiration lumen. To the contrary, Saravia is silent regarding accumulator 29 or balloon 198 being configured to expand during occlusion of an aspiration lumen when the accumulator is located separate from an irrigation line. Nor is it reasonable to expect that balloon 198 would expand during an occlusion, since the pressure in an aspiration line decreases during an occlusion, which would tend to cause the walls of balloon 198 to contract during the occlusion.

In response to Applicants' argument in the Response submitted on June 19, 2009 (herein referred to as the "June Response"), the Office Action asserts on page 2 that Saravia discloses an action of alternatively holding or not holding a plunger open, and that such action would be feasible and able to be accomplished with suction flow. However, even if such action of plunger 214 of Saravia were possible in suction flow, there is no disclosure or suggestion by Saravia that accumulator 29 or balloon 198, if located in a suction flow, would expand during occlusion of an aspiration lumen, as required by claim 1.

Claims 3 and 4 depend from claim 1. Therefore, claims 3 and 4 are patentable over Saravia at least for the same reasons that claim 1 is thereover and are patentable in their own right as well. Claim 15 is patentable over Saravia for similar reasons as those for which claim 1 is patentable thereover.

Claims 2 and 14 Are Patentable Over Saravia and Urich.

Claims 2 and 14 depend from claim 1. The disclosures of Urich do nothing to cure the defects of Saravia with regard to the limitation of a tubular member separate from, and in a parallel fluid relationship with, an irrigation line. Therefore, claims 2 and 14 are patentable over Saravia and Urich at least for the same reasons that claim 1 is patentable thereover and are patentable in their own right as well.

Claims 5, 7, and 9 Are Patentable Over Saravia and Rehn.

Claims 5, 7, and 9 depend from claim 1. The discloses of Rehn do nothing to cure the defects of Saravia with regard to the limitation of a tubular member separate from, and in a parallel fluid relationship with, an irrigation line. Therefore, claims 5, 7, and 9 are patentable over Saravia at least for the same reasons that claim 1 is thereover and are patentable in their own right as well.

Claims 29-32 are patentable over Saravia and Rehn.

Claim 29 is patentable over Saravia for similar reasons as those for which claim 1 is patentable over Saravia, and is patentable in its own right as well. Claims 30-32 depend from claim 29 and further define the invention of claim 29. Thus, claims 30-32 are patentable over Saravia and Rehn at least for the same reasons that claim 29 is patentable thereover, and are patentable in their own right as well.

Claims 33, 35, and 37 are patentable over Saravia, Sepielli, and Rehn.

Claims 33, 35, and 37 depend from claim 29. The discloses of Sepielli and Rehn do nothing to cure the defects of Saravia with regard to the limitation of a tubular member separate from, and in a parallel fluid relationship with, said irrigation line. Therefore, claims 33, 35, and 37 are patentable over Saravia, Sepielli, and Rehn at least for the same reasons that claim 29 is patentable thereover and are patentable in their own right as well.

Claims 10-11, 23-24, and 38-39 Are Patentable Over Saravia, Sepielli, and Rehn.

The current Office Action has indicated that claims 23 and 24 would be allowable if rewritten in independent form including all of the limitation of the base claim and any intervening claims. Claim 23 has been so amended, while claim 24 depends from claim 23. Accordingly, claims 23 and 24 are now believed to be in condition for allowance.

Claims 10-11 depend from claim 1, while claims 38-39 depend from claim 37. Applicants have argued above that claims 1 and 37 are patentable over Saravia, Sepielli, and Rehn. Thus, claims 10-11 and 38-39 are patentable over Saravia, Sepielli, and Rehn at least for the same reasons claims 1 and 37 are patentable thereover and are patentable in their own right as well. In addition, the current Office Action has indicated that claims 10-11 and 38-39 contain allowable subject matter.

CONCLUSION

Based on the foregoing, Applicants respectfully assert that the claims now pending are allowable over the prior art. Therefore, Applicants earnestly seek a notice of allowance and prompt issuance of this application.

The Commissioner is hereby authorized to charge payment of any fees associated with this communication to Deposit Account No. 502317.

Respectfully submitted,
Advanced Medical Optics

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By: /David Weber/

David Weber
Registration No. 51,149
Agent of Record
Customer No. 33357
(714) 247-8232